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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,670	12/09/1999	YOICHI SHIMAZAWA	SAOL.P0107US	6754

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EXAMINER

TRAN, DOUGLAS Q

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/456,670

Applicant(s)

SHIMAZAWA ET AL.

Examiner

Douglas Q. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4,5. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamamoto et al. (US Patent No. 5,652,830) and Nishizawa (US Patent No. 5,987,228).

As to claim 1, Yamamoto teaches an image forming apparatus (i.e., a printer in fig. 18) for forming an image based on image data inputted from an arbitrary image output apparatus (i.e., a host computer in fig. 18; col. 30, lines 13-21: one of printers receives the print data from one of host computers and forms an image in steps of S108 and S119 in fig. 20), the image forming apparatus performing:

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a judging process of judging whether identification information (i.e., an ID code) is entered and matched with the ID code has been inputted together with the image data (col. 31, lines 8-11) and also with host machine identification (col. 30, lines 52-56) from an arbitrary output apparatus (i.e., one of the host machines in fig. 18),

(it is noted that, col. 31, lines 28-29 and 63-67, a judgment process of judging whether an ID code is entered through the ID input section and whether the entered ID code is matched with the ID code stored in the memory 102. The ID code has been inputted together with host machine identification and print data “col. 30, lines 52-56 and col. 31, lines 8-11” are sent to a printer for print out. The host machine number would be also considered as identification information of the output apparatus);

an image formation process (in step of S119 in fig. 20) is performed to form an image based on the image data only when the identification information (i.e., an ID code) has been inputted together with image data (it is noted that because the printer performs the printing out for the confidential print data send from the host machine, the printer would perform to form an image based on image data only when the printer receives the ID code has been inputted together with image data from the host machine “col. 31, lines 8-11”; and the process further for forming the image only occurs when the ID code is confirmed at the input section 106 “col. 31, line 63 to col. 32, line 10”).

However, Yamamoto does not teach a judging process of judging whether identification information of the host machine transmitted from the host machine.

Nishizawa teaches a judging process of judging (the process from the name-identifier judging unit 4 in fig. 4 ) whether identification information which identifies the image output

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apparatus (col. 3, lines 47-51; it is noted that the name-identifier or the name of a print request issuer would be representative of either a user or a host computer “col. 1, lines 13-14”) outputted together with the print request (col. 2, lines 43-48).

(it is noted that a network printing apparatus “i.e., a network printer” receives the print request “col. 2, lines 31-32”, the name-identifier judging unit for judging whether or not the name identifier for identifying the print request issuer has been inputted within the print request “col. 2, lines 43-48”. The name of the print request issuer would be representative of either a user or a host computer “col. 1, lines 13-14”. After the name of print request issuer is determined “col. 3, lines 1-2”, the right determining unit allows the print request issuer to access the network printing apparatus by its right “col. 3, lines 2-8”. In briefly, the network printing apparatus performs the printing out the print data after the print-request issuer got its right).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the judging process in Yamamoto for judging whether the identification information of the host computer in the print request transmitted from the host computer as taught by Nishizawa so that the printer in Yamamoto to perform the image data when the identified host computer is determined. The suggestion for modifying the printing system of Yamamoto can be reasoned by one of ordinary skill in the art as set forth above by Nishizawa because the modified printing system of Yamamoto would be flexible and faster but also confidential by performing to form an image data only when the identification information of the host computer in the network is determined from the judging process, instead of waiting the input of ID code from the user at the printer.

As to claim 2, Yamamoto and Nishizawa disclose every feature discussed in claim 1, and Yamamoto further teaches that the judging process is performed to judge whether identification information which is a piece of data (i.e., ID code or host machine number in fig. 19) different from the image data (i.e. print data in fig. 19) has been inputted as an attachment to the image data (it is noted that the information of ID codes or host machine number information are located in different with the print data and are attached to the print data; please see fig. 19 and col. 30, lines 52-57).

5. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamamoto and Nishizawa as applied to claim 1 above, and further in view of Hisatomi et al. (US Patent No. 6,342,954 B1).

As to claim 4, Yamamoto and Nishizawa disclose every feature discussed in claim 1.

However, neither Yamamoto nor Nishizawa teach the image formation process is performed to form an image based on the image data on a portion of which image data of an identification pattern representing the identification information is superimposed.

Hisatomi teaches the image formation process (i.e., from an image printer 112 in fig. 1) is performed to form a superimposed image (col. 3, lines 42-43) based on the image data on a portion of which image data of an identification pattern representing the identification information is superimposed (i.e., a bar code; the bar code superimposes with an image of specific page in fig. 6 and 7) (col. 3, lines 38-42: the identification information for identifying a predetermined electronic document file stored in the storage means is superimposed on image information of a specific page of that file by the image superimposing and outputting means. It is clearly noted that, col. 6, lines 12-24, the CPU reads out the file name of the file as storage

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location information and converts it into a bar code. The bar code may be a character string. Then the CPU take out the first page of the image being read out and superimposes the bar code on the image of the cover page to form a superimposed image; and this superimposed image is printed out through the image printer 112).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image formation process of the combination of Yamamoto and Nishizawa for forming the superimposed image in which the image data is superimposed with identification pattern representing the identification information as taught by Hisatomi. The suggestion for modifying the printing system of Yamamoto and Nishizawa can be reasoned by one of ordinary skill in the art as set forth above by Hisatomi because the modified image formation process of Yamamoto and Nishizawa would be more confidential when the identification information is recorded together with the inputted image data on the recording medium. Therefore, the operator at the printer can recognize who or where the recorded products belong.

As to claim 7, Yamamoto, Nishizawa and Hisatomi disclose every feature discussed in claim 4, and Hisatomi further teaches the image formation process is performed to superimposed the image of the identification pattern (i.e., a bar code in step of 204 in fig. 2) with reduced visibility on a portion of the image formed based on the inputted image data (i.e., the image of cover page of electronic document file in step of 204 in fig. 2) (please see figure 6 and 7: the bar code is appeared on the corner of the image of cover page in a form of reduced visibility; and the bar code is small and not overlapped with any information of the image data of the cover page).

*Allowable Subject Matter*

6. Claim 3 is objected to as being dependent upon a rejected base claim 1, and claims 5-6 are objected to as being dependent upon a rejected base claims 1 and 4, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for objecting:

As to claim 3, which depends on claim 1, the closest prior art of Yamamoto et al. (US Patent No. 5,652,830), Nishizawa (US Patent No. 5,987,228) and an updated electronic text search, taken either singly or in combination, does not teach: the judging process is performed to judge whether the identification information of the image output apparatus is ***included as part of the inputted image data.***

As to claim 5, which depends on claims 1 and 4, the closest prior art of Yamamoto et al. (US Patent No. 5,652,830), Nishizawa (US Patent No. 5,987,228), Hisatomi et al. (US Patent No. 6,342,954 B1) and an updated electronic text search, taken either singly or in combination, does not teach: an image of an identification pattern representing the identification information, which ***identifies the image output apparatus,*** is created and the created image is superimposed on a portion of the image formed based on the inputted image data.

As to claim 6, which depends on claims 1 and 4, the closest prior art of Yamamoto et al. (US Patent No. 5,652,830), Nishizawa (US Patent No. 5,987,228), Hisatomi et al. (US Patent No. 6,342,954 B1) and an updated electronic text search, taken either singly or in combination, does not teach: an image of an identification pattern representing the identification information which



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*identifies the image forming apparatus* itself is created and the created image is superimposed on a portion of the image formed based on the inputted image data.

***Examiner's Remarks***

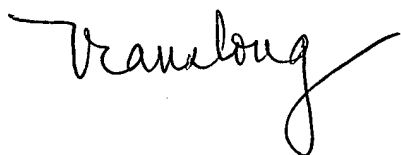
Yamamoto et al. (U.S. Patent No. 6,095,566) discloses an image recording system superimposes, on an original image, an additional image which is same as at least any one of visible characters, symbols and numerals recorded on a recorded product as an image for certification. The additional image superimpose=recorded on the recorded product cannot visually be recognized and it is permitted to be visible when a universal optical filter is used.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran  
Feb. 21, 2003

A handwritten signature in black ink, appearing to read "Tran Douglas", with a long, sweeping horizontal stroke extending to the right.